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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/137,393	08/20/1998	PIJUSH K. DEWANJEE	DSCK-525-C3	2824

7590

07/16/2003

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EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 07/16/2003.

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/137,393

Applicant(s)

DEWANJEE ET AL.

Examiner

Rabon Sergent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-33,36-41 and 43-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-33,36-41 and 43-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 30-33, 36-41, and 43-52 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Adequate support has not been provided for the subject matter pertaining to the preservation of the core compression during post cure at the specified temperatures. Furthermore, adequate support has not been found for the subject matter of claim 44 pertaining to the respective hindrances of the benzene curing agents. Support exists only for a discussion of hindrance as it pertains to the exemplified curing agents.
2. Claims 44-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear with respect to what definitive limitation is conveyed by the term, "without reduced properties". It is unclear what properties are being referred to.

3. Claims 48-50 and 52 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the production of golf ball covers using toluene diisocyanate, 4,4'-diphenylmethane diisocyanate, isophorone diisocyanate, or mixtures thereof, does not reasonably provide enablement for the production of golf ball covers using virtually any benzene ring containing polyisocyanate. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Aside from the aforementioned polyisocyanates,

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applicants have provided no guidance for the selection of other suitable polyisocyanates that will yield cast polyurethanes having suitable physical properties for use as golf ball covers.

Applicants' argument that the skilled artisan could readily determine what isocyanates are suitable without having to resort to undue experimentation amounts to unsubstantiated opinion.

The specification contains no suggestion that the wide range of argued polyisocyanates could be successfully used in the practice of the instant invention; it is noted that applicants stress the difficulties of using MDI, a conventional polyisocyanate in the production of golf balls; therefore, it is not logical that even less conventional polyisocyanates could be used without further guidance in the production of viable golf balls.

4. Claims 44-46 and 48-52 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the production of golf ball covers using diethyl-2,4-toluenediamine and dimethylthio-2,4-toluenediamine, does not reasonably provide enablement for the production of golf ball covers using virtually any blend of differently reacting diamines. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification is devoid of guidance that would enable one to select suitable blends of differently reacting diamines that will yield suitable golf ball covers having viable processing characteristics and suitable golf ball properties. The only practical guidance provided by applicants stems from page 11 of the specification, wherein applicants state that the curing agents of the present invention are substantially Ethacure 300 and Ethacure 100. Applicants' argument that the skilled

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artisan could readily determine what blends of curing agents are suitable without having to resort to undue experimentation amounts to unsubstantiated opinion.


5. Claims 30, 31, 33, 36-40, and 44-51 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the production of golf ball covers using polyoxytetramethylene polyol, does not reasonably provide enablement for the production of golf ball covers using virtually any ether glycol. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Applicants have failed to provide adequate teaching to permit one of ordinary skill in the art to produce viable golf ball covers using polyols other than the aforementioned polyoxytetramethylene polyol. The only guidance that applicants provide concerning the use of other polyols is a statement at page 14 that states that “unlike urethane elastomers made with other ether polyols, e.g., polypropylene ether glycol, urethane elastomers made with PTMEG exhibit superior dynamic properties such as coefficient of restitution and Bashore rebound”. Applicants further state that the polyol used in accordance with the present invention corresponds to a polyoxytetramethylene polyol. These statements in no way provide guidance for the use of other polyols. Applicants’ argument that the skilled artisan could readily determine what polyols are suitable without having to resort to undue experimentation amounts to unsubstantiated opinion.

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6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

July 13, 2003